

Pursuant to 37 CFR 1.125, a marked-up version showing the amendments to be entered into the specification and a clean version of the pages on which amendments have been made is included along with this response.

It is believed that no new matter has been added to the specification with the amendments to the specification and claims, and that the amendments are fully supported by the specification as filed. A clean copy of the specification paragraph incorporating the amendment is included with this filing.

IN THE CLAIMS

The patent application accompanying this paper is filed as a division of co-pending application number 09/755,274 filed January 5, 2001. The application was subjected to an ELECTION/RESTRICTION REQUIREMENT by the Office mailed February 25, 2002. The Applicant(s) previously elected Group I claims, claims 1-5, drawn to isolated peptides, with traverse. The Applicant was subsequently required to elect a single species among the several species included in the Markush groupings in the several claims. The Applicant elected SEQ ID NO:21. The Applicant reserves the right to file further divisional applications claiming in similar fashion the balance of the several species remaining in the case, and if necessary, claiming each species separately and individually in as many divisional applications based on those Group I claims.

With the filing of this divisional application, however, the Applicant herewith elects Group III claims, claims 8-10, drawn to a method for protecting a plant from Coleopteran insect infestation. Claim 9 also includes a Markush grouping of species much like the earlier elected claims in the prior case as set forth above. The Examiner has also required an election of a species for further prosecution of these Group III elected claims, and therefore the Applicant herewith, with traverse, elects SEQ ID NO:21.

Please cancel claims 1-7 and 11-12 without prejudice.

The Examiner asserts that the sequences in the claims, and now in particular, in the elected claims, should be limited to a single sequence, allegedly because the Examiner believes that the sequences as disclosed are not capable of use together, and that each has a different function and/or a different effect. However, the specification clearly sets out that these sequences as disclosed are capable of use together (page 38, lines 14-16), and that the sequences do not have different functions or different effects (specification page 37, lines 20-29). The sequences in the elected claims are all patatin or non-specific lipid-acyl-hydrolases that exhibit insect inhibitory biological activity. The sequences therefore are capable of use together, and do not have different functions or different effects and therefore should not be considered as separately patentable inventions, and it is believed that the Applicants should not be

required to limit the scope of the claims to a single sequence or species of those sequences claimed as set forth in the specification and the claims.

Therefore, the claims 8-10 are not amended with the filing of this Divisional Application and election of Group III. However, to be fully responsive, the Applicants are required to elect a single sequence for prosecution, and therefore as indicated above, the Applicants elect SEQ ID NO:21.

A complete listing of all claims in the application is included along with this paper according to the procedures as set forth in the revised 37 CFR §1.121.

It is respectfully requested that the Examiner find the claims in condition for allowance and an early notification of such is requested. In the event that there are minor corrections or modifications necessary for allowance, or if the Examiner should have any questions, it is respectfully requested that the Examiner contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Ball', is written over a horizontal line.

Timothy K. Ball, Ph.D., Esq.

Reg. No. 42,287

Corporate Counsel - Intellectual Property

Monsanto Company

800 North Lindbergh Blvd., Mail Zone E2NA

St. Louis, Missouri 63167

(314) 694-5811

FAX (314) 694-5311

COMPLETE LISTING OF ALL CLAIMS IN THE APPLICATION

Claims 1 – 7 (canceled)

Claim 8. (Original) A method for protecting a plant from Coleopteran insect infestation comprising providing to said plant a Coleopteran insect inhibitory amount of a protein exhibiting lipid acyl hydrolase activity, wherein said protein comprises

- a) a first motif comprising Gly-Xaa₁-Ser-Xaa₂-Gly as set forth in SEQ ID NO:14, wherein Xaa₁ and Xaa₂ are Ser or Thr;
- b) a second motif comprising Glu-Xaa₁-Xaa₂-Leu-Val-Asp-Gly as set forth in SEQ ID NO:15, wherein Xaa₁ comprises the amino acids selected from the group consisting of Tyr, Phe, and Trp, and wherein Xaa₂ comprises the amino acids selected from the group consisting of His and Asn; and
- c) a third motif comprising Phe-Tyr-Xaa₁-Glu-Xaa₂-Gly-Pro as set forth in SEQ ID NO:42, wherein Xaa₁ comprises the amino acids selected from the group consisting of Phe, Ile, and Leu, and wherein Xaa₂ comprises the amino acids selected from the group consisting of His and Asn.

Claim 9. (Original) The method according to claim 8 wherein said protein is selected from the group consisting of SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5, SEQ ID NO:6, SEQ ID NO:9, SEQ ID NO:10, SEQ ID NO:11, SEQ ID NO:12, SEQ ID NO:13, SEQ ID NO:21, SEQ ID NO:23, SEQ ID NO:25, SEQ ID NO:27, SEQ ID NO:29, SEQ ID NO:31, SEQ ID NO:33, SEQ ID NO:35, SEQ ID NO:36, SEQ ID NO:40, and SEQ ID NO:41.

Claim 10. (Original) The method according to claim 8 wherein said protein is not naturally occurring.

Claims 11 – 12 (Canceled)